

Appl. No. 09/824,454
Atty. Docket No. 8047
Reply Dated Mar. 17, 2005
Reply to Office Action of Dec. 17, 2004

REMARKS

Claims 1-5 and 8 are pending in the present application and stand rejected.
Claims 1-5 and 8 have been rejected.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-2 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,505,719 to Cohen et al. (hereafter "Cohen"). In support of this rejection, the Office states, "The Cohen reference teaches outer layers, and the second and third layers, in combination, are analogous to the inner layer claimed by Applicant." The Office asserts that "the second and third layers are essentially sublayers that in combination are equivalent to the claimed inner layer." Applicant traverses this rejection.

It is important to review what Cohen discloses. Cohen relates to a multilayered absorbent structure having a plurality of planar absorbent regions defined by decreasing pore size with increasing depth in the planar region." Col. 4, lines 12-15. Cohen presents a four layer laminate with the following composition:

- First Layer comprising 10-100 wt% synthetic fibers and 0-90 wt% natural fibers.
- Second Layer comprising 10-100 wt% synthetic fibers and 0-90 wt% natural fibers.
- Third Layer comprising 10-100 wt% synthetic fibers and 0-90 wt% natural fibers.
- Fourth Layer comprising 10-100 wt% synthetic fibers and 0-90 wt% natural fibers.

Col. 5, line 53 – Col. 8, line 26. Cohen states that "synthetic fiber-rich structures can be . . . formed with conventional air-laid equipment, such as card-and-bind equipment." Col. 8, lines 55-58.

Case law states that, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); *See also* MPEP § 2131. Case law further states, "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be *identically* shown in a single reference." *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677, 7 U.S.P.Q.2d 1315 (Fed. Cir. 1988) (emphasis added). In the Office

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Action dated July 2, 2004, the Office asserted that either the second or third layer of Cohen corresponds to Applicant's claimed inner layer. However, regardless of which layer is chosen (i.e., the second or third layer), the chosen layer is not bound in a face to face relationship with the first fibrous outer layer and with the second fibrous outer layer. The Office now asserts that the second and third layers of Cohen are sublayers that, if taken in combination, are equivalent to Applicant's claimed inner layer. The Office misconstrues Cohen on at least two grounds.

First, Cohen rebuts the assertions that the second and third layers are merely sublayers that can be combined as a single layer. Cohen states that "each planar region is defined by a generally decreasing average pore size." Col. 4, lines 27-28. The use of varying pore sizes appears necessary to "improv[ing] the sequestering of liquids within the absorbent structure." Col. 4, lines 33-34. Therefore, the second and third layers are distinct with respect to pore size. The Office should not equate the second and third layers as indistinguishable when they are clearly disclosed as being distinct.

Second, the Office's combination of the second and third layers to be equivalent to Applicant's inner layer is arbitrary. The Office has provided no reason as to why the second and third layers should be considered capable of combination. The Office asserts that the second and third layers can be considered sublayers. Given the Office's reasoning, any of the layers presented in Cohen could then be combined. Applicant asserts that the first, second, third, and fourth layers of Cohen can just as reasonably be considered sublayers, which results only in a change of terminology (i.e., layers now are termed sublayers).

In light of the arguments presented above, Cohen does not teach or suggest each and every limitation present in Applicant's Claim 1. Applicant requests reconsideration and withdrawal of this rejection.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Applicant respectfully submits that the Office has failed to make a *prima facie* case for the obviousness rejection presented below. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or

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motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. See *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); MPEP § 2143.01. Second, there must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP § 2143.02. Third, the prior art reference or combined references must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981 (CCPA 1974); MPEP § 2143.03. Furthermore, the Court of Appeals for the Federal Circuit has stated that “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443 (Fed. Cir. 1992).

Claims 3-5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Cohen. With regard to Claims 3-5, the Office states, “While the Cohen reference is not concerned with the properties of claims 3-5, the invention is used in the same capacity as the claimed invention . . . and is made of the same materials. It would therefore be obvious to one of ordinary skill in the art to optimize the claimed properties.” Applicant traverses the Office’s rejection

First, the Office has not applied the Graham factors as enunciated in *Graham v. John Deere*, 383 U.S. 1 (1966). There appears to be no determination of the differences between Cohen and the claims in issue. There appears to be no resolution as to the level of ordinary skill in the pertinent art. Since the Office has not applied the Graham factors, a *prima facie* case of obviousness has not been established.

Second, the Office has failed to teach or suggest all the claim limitations. Claims 3-5 are dependent from and include all the limitations of Claim 1. As argued above, the Office has failed to present evidence that Cohen teaches or suggests each and every limitation of Applicant’s Claim 1. Namely, Cohen does not teach or suggest the multi-layer web of the present invention. Since Claim 1 is nonobvious in light of the arguments presented above, Claims 3-5 are likewise nonobvious.

As a result of the arguments presented above, Applicant requests reconsideration and withdrawal of this rejection

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CONCLUSION

Based on the foregoing reasons, Applicant respectfully submits that all rejections have been addressed and traversed. Reconsideration and withdrawal of the rejections are respectfully requested. Allowance of each of the pending claims is earnestly requested.

Respectfully Submitted,

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